APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,770	01/16/2001	Sumit Gupta	0007056-0073/P5380/RJL	7447

23879 7590 03/08/2004		EXAMINER
BRIAN M BERLINER, ESQ		NGUYEN BA, PAUL H

ART UNIT	PAPER NUMBER
2176	6

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DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	09/764,770	GUPTA, SUMIT
	Examiner	Art Unit
	Paul Nguyen-Ba	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _6/10/2002_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-18_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-18_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1.   This action is in response to communications:

   a.   Original Application as filed on January 16, 2001,

   b.   Drawings filed on March 26, 2001, and

   c.   Notice Regarding Power of Attorney filed on June 10, 2002.

2.   Claims 1-18 have been considered. Claims 1 and 10 are independent claims.

3.   If a copy of a provisional application listed on the bottom portion of the accompanying

Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-

892 has been annotated to indicate that the copy was not readily available, it is because the copy

could not be readily obtained when the Office action was mailed. Should applicant desire a copy

of such a provisional application, applicant should promptly request the copy from the Office of

Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under

37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to

this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a

substantial delay by the Office in fulfilling the order for the copy of the provisional application.

Where the applicant has been notified on the PTO-892 that a copy of the provisional application

is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will

be automatically furnished without charge does not apply.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1, 2, 5, 6, 8-11, 14, 15, 17, and 18 are rejected under 35 U.S.C. 102(e) as being

anticipated by Torchalski, U.S. Patent Application Publication No. US 2002/0074408.

Independent Claim 1

Torchalski discloses *a method for converting, a physical document into an electronic*

document (see Abstract) comprising:

inserting one or more formatting commands into an initial electronic document (pg. 1 -

[0004], [0010], [0011]; pg. 2 - [0023], [0028]; pg. 3 - claim 9; see also Figure 1 → user can

embed command codes into the initial electronic document which subsequently controls specific

formatting features of the label document prior to printing);

converting said initial electronic document into a physical document (pg. 1 – [0004],

[0010], [0011]; pg. 2 – [0028],[0029] → i.e. uses the label format to prints label documents);

scanning said physical document using a scanner to produce an electronic document (see

Abstract; pg. 1 – [0002], [0006]-[0012]) *wherein said scanner is configured to interpret said*

formatting commands (pg. 2 – [0022], [0027]; pg. 3 – [0030], [0031], claims 9 and 10 → creates

a label format by scanning an existing, printed label document which was created using a

specific command language prior to being scanned. Hence, user does not have to manually

interpret and measure various formatting conventions of physical label documents).

Claims 2, 5, 6, and 8

Torchalski discloses the *method* of claim 1 wherein said formatting commands are *fonts,*

tabs, margins, and picture definitions (pg. 1 – [0006] → i.e. fonts, tabs, margins, and graphics).

Claim 9

Torchalski discloses the *method* of claim 1 wherein said step of converting further

comprises:

placing one or more bar codes into said physical document (pg. 1 – [0003]-[0006] →

user can design and place barcodes on to electronic document to later print the barcodes on

physical label documents).

Independent Claim 10

Torchalski discloses a *computer program product* comprising:

a computer usable medium having computer readable program code embodied therein

configured to convert a physical document into an electronic document (see Abstract), said

computer program product comprising:

computer readable code configured to cause a computer to insert one or more formatting

commands into an initial electronic document (pg. 1 - [0004], [0010], [0011]; pg. 2 - [0023],

[0028]; pg. 3 - claim 9; see also Figure 1 → computer readable code that allows user to embed

command codes into the initial electronic document which subsequently controls specific

formatting features of the label document prior to printing);

computer readable code configured to cause a computer to convert said initial electronic document into a physical document (pg. 1 – [0004], [0010], [0011]; pg. 2 – [0028],[0029] → i.e. computer readable code uses the label format to prints label documents);

computer readable code configured to cause a computer to scan said physical document using a scanner to produce an electronic document (see Abstract; pg. 1 – [0002], [0006]-[0012]) *wherein said scanner is configured to interpret said formatting commands* (pg. 2 – [0022], [0027]; pg. 3 – [0030], [0031], claims 9 and 10 → computer readable code creates a label format by scanning an existing, printed label document which was created using a specific command language prior to being scanned. Hence, user does not have to manually interpret and measure various formatting conventions of physical label documents).

Claims 11, 14, 15, and 17

Torchalski discloses the *computer program product* of claim 10 wherein said *formatting commands are fonts, tabs, margins, and picture definitions* (pg. 1 – [0006] → i.e. fonts, tabs, margins, and graphics).

Claim 18

Torchalski discloses the *computer program product* of claim 10 wherein said *computer readable code configured to cause a computer to convert further comprises computer readable code configured to cause a computer to place one or more bar codes into said physical document* (pg. 1 – [0003]-[0006] → computer readable code allows user can design and place barcodes on to electronic document to later print the barcodes on physical label documents).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   Claims 3, 4, 7, 12, 13, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Torchalski, U.S. Patent Application Publication No. US 2002/0074408.

Claims 3, 4, and 7

Torchalski discloses *a method for converting, a physical document into an electronic*

document (see Abstract) comprising:

inserting one or more formatting commands into an initial electronic document (pg. 1 -

[0004], [0010], [0011]; pg. 2 - [0023], [0028]; pg. 3 - claim 9; see also Figure 1);

converting said initial electronic document into a physical document (pg. 1 – [0004],

[0010], [0011]; pg. 2 – [0028],[0029]);

scanning said physical document using a scanner to produce an electronic document (see

Abstract; pg. 1 – [0002], [0006]-[0012]) *wherein said scanner is configured to interpret said*

formatting commands (pg. 2 – [0022], [0027]; pg. 3 – [0030], [0031], claims 9 and 10), but does

not specifically disclose the method wherein said formatting commands are font sizes, alignment

tags, and table definitions.

However, Torchalski discloses the *method* of claim 1 wherein said formatting commands

are *fonts, tabs, margins, and picture definitions* (pg. 1 – [0006] → i.e. fonts, tabs, margins, and

graphics) for the purpose of increasing the accuracy of optical character recognition software

related to scanning physical documents.

It would have been obvious at the time the invention was made to a person having

ordinary skill in the art to modify the teaching of Torchalski to include the additional formatting

commands such as font sizes, alignment tags, and table definitions for the purpose of increasing

the accuracy of optical character recognition software related to scanning physical documents.

Claims 12, 13, and 16

Torchalski discloses a *computer program product* comprising:

a computer usable medium having computer readable program code embodied therein

configured to convert a physical document into an electronic document (see Abstract), said

computer program product comprising:

computer readable code configured to cause a computer to insert one or more formatting

commands into an initial electronic document (pg. 1 - [0004], [0010], [0011]; pg. 2 - [0023],

[0028]; pg. 3 - claim 9; see also Figure 1);

computer readable code configured to cause a computer to convert said initial electronic

document into a physical document (pg. 1 – [0004], [0010], [0011]; pg. 2 – [0028],[0029]);

computer readable code configured to cause a computer to scan said physical document using a

scanner to produce an electronic document (see Abstract; pg. 1 – [0002], [0006]-[0012])

wherein said scanner is configured to interpret said formatting commands (pg. 2 – [0022],

[0027]; pg. 3 – [0030], [0031], claims 9 and 10), but does not specifically disclose the computer

program product wherein said formatting commands are font sizes, alignment tags, and table

definitions.

However, Torchalski discloses the *computer program product* wherein said formatting commands are *fonts, tabs, margins, and picture definitions* (pg. 1 – [0006] → i.e. fonts, tabs, margins, and graphics) for the purpose of increasing the accuracy of optical character recognition software related to scanning physical documents.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Torchalski to include the additional formatting commands such as font sizes, alignment tags, and table definitions for the purpose of increasing the accuracy of optical character recognition software related to scanning physical documents.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (703) 305-8776. The examiner can normally be reached on 9 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER